

REMARKS

Introduction

Claims 1-64 were pending in this application.

Applicant has amended claims 1 and 11 and has added claims 65-84 to more particularly define the invention. Applicant has cancelled claims 33-64 without prejudice. No new matter has been added and the amendments and new claims are fully supported and justified by the specification.

Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Summary of the Office Action

Claims 1, 11, 33, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson et al., G.B. Patent No. 2,147,773 (hereinafter "Dickinson") in view of Sarno, U.S. Patent No. 6,024,641 (hereinafter "Sarno").

Claims 1-5, 7, 9, 11-15, 17, 19, 33-37, 39, 41, 49-53, 55, and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli et al., U.S. Patent No. 5,921,865 (hereinafter "Scagnelli") in view of Fraser et al., U.S. Patent No. 5,329,589 (hereinafter "Fraser") in further view of LottoBot, <http://lotobot.net> (hereinafter "LottoBot").

Claims 6, 16, 38, and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of Luciano et al., U.S. Patent No. 6,168,521 (hereinafter "Luciano").

Claims 8, 18, 40, and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of SGI Insights, Scientific Gaming International, vol. 1, issue no. 5 (January 1999) (hereinafter "SGI").

Claims 10, 20, 39, 42, and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of McCollom et al., U.S. Patent Application Publication No. 2002/001623 A1 (hereinafter "McCollum").

Claims 21-32, 43-48, and 59-64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,325,716 B1 (hereinafter "Walker") in view of Archer, U.S. Patent No. 6,277,026 (hereinafter "Archer").

Applicant's Reply to the Rejection of
Claims 1 and 11 Under 35 U.S.C. § 103(a)

Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson in view of Sarno. The Examiner's rejections are respectfully traversed.

Applicant's invention, as defined by amended independent claims 1 and 11, is directed toward a method and system for allowing a user in a particular location to participate in lottery wagering using user equipment. An interactive wagering application is used to visually display a listing of lotteries, in which the user may participate on the user equipment, based on the particular location of the user. The interactive wagering application gives the user the ability to participate in at least one of the lotteries. The user, for example, may only be presented with a listing of lotteries which may legally be played from the user's location (i.e., a particular state lottery that is only allowed to be played within the state with which the lottery is associated).

Dickinson refers to a lottery game terminal that provides a plurality of user selectable lottery games and is capable of operating in a multi-terminal statewide lottery game system. The plurality of user selectable lottery games available to a player do not depend on the location of the terminal.

Sarno refers to a lottery gaming system in which a user may remotely participate in a remote lottery drawing via a network or by some other remote means. The winning lottery numbers are determined by "objective and verifiable elements, such as, for example, a portion of the closing stock market price on a given day for a specified set of markets." Sarno, column 3, lines 6-10. The advantage of this system is that the users can be confident that the winning combination is not "rigged" by the provider. Id.

The Examiner asserts that Dickinson teaches all of the features of applicant's independent claims, except using user equipment. The Examiner "interprets 'user equipment' to mean equipment that is the possession of [a] player (e.g. owner or leased) rather than owner or operated by [a] game vendor." Office Action, page 2. The Examiner asserts that Sarno teaches that it is known in the art to offer lottery games on user equipment.

Irrespective of what "user equipment" is, which applicant shall not address here, nothing in either Dickinson or Sarno shows or suggests providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user. Therefore, whether taken alone or in combination, both Dickinson and Sarno fail

to show the features of applicant's invention as defined by independent claims 1 and 11.

Moreover, applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves

or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Dickinson or Sarno that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Dickinson and Sarno, the Examiner merely concludes that it would have been obvious to add the feature of using user equipment in Dickinson because "allowing players to participate in lotteries from their homes using user equipment offers several benefits." Office Action, page 2. The fact that adding a feature would offer benefits is not an objective teaching that would lead one of ordinary skill in the art to combine the references to obtain applicant's invention.

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the

references. With the knowledge of applicant's novel system for allowing a user in a particular location to participate in lottery wagering using user equipment, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Dickinson and Sarno. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Dickinson with the teachings of Sarno, applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

In fact, Dickinson teaches away from a combination with Sarno. Dickinson relates to a specialized lottery game

terminal for use in a secure lottery system. The terminal is specially designed, physically and logically, for its intended purpose. Sarno, however, relates to an insecure lottery system which may be accessed using standard user equipment. Because Dickinson and Sarno relate to different types of lottery systems with different types of requirements for their respective terminals, Dickinson teaches away from being combined with Sarno.

Accordingly, applicant's amended claims 1 and 11 are allowable over Dickinson in view of Sarno. Applicant respectfully requests that the rejection of claims 1 and 11 be withdrawn.

Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser. The Examiner's rejections are respectfully traversed.

Scagnelli refers to a lottery wagering system in which a user may use a touch-tone telephone to participate in a lottery. According to Scagnelli, the user, after calling a specified number, is welcomed by a voice responsive unit (VRU), which asks for information needed to participate in a lottery using voice prompts. The VRU receives user responses via touch-tone signals generated when the user presses buttons on a telephone keypad.

Fraser refers to a method of employing a communications system to mediate different types of transactions. In one variation of the system, Fraser refers to a communications system where a telephone can be replaced with a display terminal and a keyboard.

The Examiner asserts that "[i]n view of Fraser, it would have been obvious to modify the lottery system disclosed by Scagnelli, wherein a telephone audibly lists lotteries in which a user can participate, to add the feature of visually displaying the lottery listings on a terminal." Office Action, page 3.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the

references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Scagnelli or Fraser that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Scagnelli and Fraser, the Examiner merely concludes that it would have been obvious to add the

feature of visually displaying information on a terminal in Scagnelli because "the modification would enhance the system by provid[ing] prompts visually using a terminal display rather than relying on voice prompts." Office Action, page 3. The fact that adding a feature would enhance the system is not an objective teaching that would lead one of ordinary skill in the art to combine the references to obtain applicant's invention.

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for providing a listing of lotteries in which the user can participate on a visual display, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Scagnelli and Fraser. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore

insufficient as a matter of law. See In re Dembiczak,
50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Scagnelli with the teachings of Fraser, applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

In fact, Scagnelli teaches away from a combination with Fraser. Applicant previously argued in the Reply to Office Action submitted on May 22, 2003 and in the Reply to Office Action submitted on October 14, 2003, and applicant still maintains that Scagnelli teaches away from the use of visual displays in favor of a telephone-based interface. The fact that Fraser refers to a system that replaces a telephone-based interface with a visual display, does not change the fact that Scagnelli teaches away from such a system. Thus, Scagnelli teaches away from being combined with Fraser.

Accordingly, for at least the above reasons, applicant's amended claims 1 and 11 are allowable over Scagnelli in view of Fraser. Applicant respectfully requests that the rejection of claims 1 and 11 be withdrawn.

Applicant's Reply to the Rejection of
Claims 21 and 27 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 21 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Archer. The Examiner's rejections are respectfully traversed.

Applicant's invention, as defined by independent claims 21 and 27, is directed towards a method and system for using an interactive wagering application to allow a user to participate in a lottery automatically. The user is given the ability to specify conditions under which he wishes to participate in the lottery via the electronic user equipment on which the interactive wagering application is at least partially implemented (i.e., by directly entering the conditions into the electronic user equipment). The interactive wagering application automatically participates in the lottery on behalf of the user when the conditions are met.

Walker refers to a lottery system in which a user must purchase tickets from a lottery agent. After entering necessary information (i.e., lottery numbers and conditions for participating) on a slip of paper by hand, the user must present the slip to a lottery agent who must then scan the slip into his lottery terminal in order to issue and print lottery tickets.

Archer refers to a system for facilitating the purchase and sale of lottery tickets online.

The Examiner asserts that "in view of Archer it would have been obvious to an artisan at the time of the invention to modify Walker, wherein users submit lottery entries using paper ticket, to instead use electronic user equipment." Office Action at pages 7-8.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to

combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Walker or Archer that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Walker and Archer, the Examiner merely concludes that it would have been obvious to combine Walker and Archer because the sale and distribution of lottery tickets online would "enhance revenues." Office Action, page 8. The fact that adding a feature would improve the system or make the system more profitable is not an objective

teaching that would lead one of ordinary skill in the art to combine the references to obtain applicant's invention.

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for allowing a user to participate in a lottery automatically using electronic user equipment, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Walker and Archer. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Walker with the teachings of Archer, applicant respectfully submits that the

Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

Accordingly, for at least the above reason, applicant's independent claims 21 and 27 are allowable. Applicant respectfully requests that the rejection of claims 21 and 27 be withdrawn.

Applicant's Reply to the Rejection of
Claims 6 and 16 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of Luciano. The Examiner's rejections are respectfully traversed.

Applicant's invention as defined by claims 6 and 16, is directed towards a method and system for recording, in a multimedia format, the lottery drawings associated with the lotteries in which a user participated.

Luciano refers to a video lottery game system using multiple player-activated video terminals that are linked to computers. Each player places a wager and selects his lottery draw choices. The system enrolls the player in a future lottery game after the player makes his choices. After the central game server generates random game selections and communicates these random game selections to the central accounting server and to the scoreboard, the

central game server records the random game selections and then repeats the process. Each video terminal may then display the results of each lottery game in such a manner as to provide the excitement of a real-time game.

The Examiner asserts that the lottery system suggested by Scagnelli in view of Fraser shows all of the features of applicant's claims except for multimedia recording of the lottery drawings associated with the lotteries in which the user participated. Regardless of this deficiency, the Examiner asserts that recording lottery drawings in a multimedia format would have been obvious to an artisan in view of Luciano.

In the Office Action of August 12, 2003, the Examiner made a similar assertion, rejecting applicant's claims as being unpatentable over Scagnelli in view of Luciano. In the instant Office Action, the Examiner has made the same rejection with the inclusion of Fraser. Applicant respectfully submits that the instant rejection is improper for the same reasons as the previous rejection.

Whether taken alone or in combination, neither Scagnelli nor Fraser nor Luciano shows recording, in a multimedia format, the lottery drawings associated with the lotteries in which a user participated. In accordance with applicant's invention, the lottery drawings associated with

the lotteries in which the user participated are recorded in a multimedia format. Luciano, however, makes no mention of recording lottery drawings in a multimedia format. Rather, Luciano merely "stores records for each lottery game . . . [e]ach lottery game record includes the lottery draws for the game and player enrollment for each game." Luciano, column 5, lines 57-60. Thus, Luciano stores the results (i.e., winning numbers) of lottery drawings in a numerical format, but does not record lottery drawings in a multimedia format as required by applicants claims.

Further, the Examiner admits that "the combination of references do not necessarily describe recording the lottery drawings in a multimedia format." Office Action, page 5. The Examiner attempts to cure this deficiency by arguing that "it was notoriously well known in the art to display game results using multimedia combinations of audio and video to enhance entertainment off games by stimulating more than on of the players senses." Id. at pp. 5-6.

Applicant respectfully submits that the entertainment value of a multimedia display is irrelevant in curing the fact that the combination in question does not show all the features of applicant's claimed invention. While Luciano may show an entertaining display, Luciano does not show recording lottery

drawings in a multimedia format as required by applicant's claims. Nor does Scagnelli. Nor does Fraser.

Therefore, whether taken alone or in combination, Scagnelli, Fraser and Luciano all fail to show the features of applicant's invention as defined by claims 6 and 16.

Moreover, applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of

obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Scagnelli, Fraser, or Luciano that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Scagnelli, Fraser and Luciano, the Examiner merely concludes that it would have been obvious to combine these references because recording lottery results in a multimedia format "enhance[s] [the] entertainment of games by stimulating more than one of the players senses." Office Action, page 6. The fact that adding a feature would have benefits is not an objective teaching that would lead one of

ordinary skill in the art to combine the references to obtain applicant's invention.

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for recording, in a multimedia format, the lottery drawing associated with lotteries in which the user participated, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Scagnelli, Fraser, and Luciano. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Scagnelli and Fraser with the teachings of Luciano, applicant respectfully submits

that the Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

In fact, Scagnelli teaches away from a combination with Fraser and Luciano. As discussed previously, Scagnelli's telephone-based interface teaches away from the use of visual displays. Because Fraser and Luciano are based entirely on a visual display interface, Scagnelli teaches away from being combined with Fraser and Luciano.

Accordingly, for at least the above reasons applicant's claims 6 and 16 are allowable over Scagnelli in view of Fraser in view of Luciano. Applicant respectfully requests that the rejection of claims 6 and 16 be withdrawn.

Applicant's Reply to the Rejection of
Claims 10 and 20 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of McCollom. The Examiner's rejections are respectfully traversed.

Applicant's invention, as defined by claims 10 and 20, is directed towards a method and system for allowing a user of an interactive wagering application to create a wager, for allowing the user to finalize the wager at a later time, and for reminding the user to finalize the wager.

McCollom refers to a system for publishing, distributing and redeeming coupons on a network. Additionally, McCollom refers to a "shopping list" or "wish list" containing items that a user stores for future purchase.

The Examiner asserts that the combination of Scagnelli and Fraser with McCollum, when taken as a whole, suggests to an artisan at a time prior to the invention, a lottery system allowing a user to purchase lottery tickets over the Internet in which the user may finalize wagers at a later time and be reminded of the need to finalize wagers.

Applicant previously argued in the Reply to Office Action, submitted on May 22, 2003, and in the Reply to Office Action, submitted on October 14, 2003, that Scagnelli and McCollom, whether taken alone or in combination, do not show or suggest giving the user the ability to finalize a wager at a later time, nor does it show or suggest reminding the user to finalize the wager. Applicant argued, and still maintains, that the mere presence of a shopping cart icon on a display in McCollom combined with the telephone based lottery system of Scagnelli is insufficient to support the Examiner's rejections. Applicant further argues that the Examiner's addition of the Fraser in the present Office Action does not cure these deficiencies.

The Examiner responds to applicant's argument by asserting that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. The Examiner argues that applicant's invention is analogous to McCollum since it is "directed to a system for executing purchases using a computer." Office Action, page 10.

Applicant respectfully submits that applicant's claimed invention is directed towards an interactive wagering application which is not an analogous system to McCollom;s system for publishing, distributing and redeeming coupons. The fact that both systems related to executing purchases used a computer is not a sufficient relationship. More importantly however, McCollom's wish list feature combined with Scagnelli and Fraser does not even show reminding a user to finalize a wager as required by applicant's claims. Thus, neither Scagnelli, nor Fraser, nor McCollom show all of the features of applicant's claimed invention.

Therefore, whether taken alone or in combination, Scagnelli, Fraser and McCollom all fail to show the features of applicant's invention as defined by claims 10 and 20.

Moreover, applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Scagnelli, Fraser, or McCollom that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Scagnelli, Fraser and McCollom, the Examiner merely concludes that it would have been obvious to combine these references because, allegedly, both systems "giv[e] users the ability to later finalize their purchases." Office Action, page 11. This reasoning does not point to any objective teaching that would lead one of ordinary skill in the art to combine the references to obtain applicant's invention, especially in light of the fact that McCollom refers to a system for publishing, distributing and redeeming coupons on a network and not a system for allowing a user to complete a wager at a later time and reminding the user to complete the wager.

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for allowing a user to complete a wager at a later time and reminding the user to complete the wager, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Scagnelli, Fraser, and McCollom. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Scagnelli and Fraser with the teachings of McCollom, applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

In fact, Scagnelli teaches away from a combination with Fraser and McCollom. As discussed previously, Scagnelli's telephone-based interface teaches away from the use of visual displays. Because Fraser and McCollom are based entirely on a visual display interface, Scagnelli teaches away from being combined with McCollom.

Accordingly, for at least the above reasons, applicant's claims 10 and 20 are allowable over Scagnelli in view of Fraser in further view of McCollom. Applicant respectfully requests that the rejection of claims 10 and 20 be withdrawn.

Applicant's Reply to the Rejection of Claims
2-5, 7-9, 12-15, and 17-19 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 2-5, 7-9, 12-15, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of LottoBot. Claims 2-5, 7-9, 12-15, and 17-19 are allowable at least because they depend from allowable independent claims 1 and 11. Applicant respectfully requests that the rejection of claims 2-5, 7-9, 12-15, and 17-19 be withdrawn.

The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of Luciano. Claims 6 and 16 have been shown to be allowable above. Claims 6 and 16 are

further allowable at least because they depend from allowable independent claims 1 and 11. Applicant respectfully requests that the rejection of claims 6 and 16 be withdrawn.

The Examiner rejected claims 8 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of SGI. Claims 8 and 18 depend from independent claims 1 and 11 and are allowable at least because claims 1 and 11 are allowable. Applicant respectfully requests that the rejection of claims 8 and 18 be withdrawn.

The Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Scagnelli in view of Fraser in further view of McCollom. Claims 10 and 20 have been shown to be allowable above. Claims 10 and 20 are further allowable at least because they depend from allowable independent claims 1 and 11. Applicant respectfully requests that the rejection of claims 10 and be withdrawn.

Applicant's Comments on the
Patentability of New Claims 65-84

Applicant's invention, as defined by new independent claims 65 and 75 are directed towards a method and system for allowing a user to participate in government lottery wagering using user equipment. An interactive wagering application is used to visually display a listing of

government lotteries in which the user may participate on the user equipment. The interactive wagering application gives the user the ability to participate in at least one of the lotteries.

Applicant respectfully submits that new independent claims 65 and 75 and new dependent claims 66-74 and 76-84 are allowable over the cited references.

Conclusion

For at least the foregoing reasons, applicant respectfully submits that this application is in condition for allowance.

Accordingly, prompt reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Alex Shvarts", is written over a horizontal line.

Alexander Shvarts

Registration No. 47,943

Attorney for Applicant

FISH & NEAVE

Customer No. 1473

1251 Avenue of the Americas

New York, New York 10020-1105

(212) 596-9000